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09/506,767	02/18/2000	Craig A. Link	MFCP.68211	8104

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EXAMINER

CHARLES, DEBRA F

ART UNIT	PAPER NUMBER
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3628

DATE MAILED: 12/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/506,767

Applicant(s)

LINK ET AL.

Examiner

Debra F. Charles

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-31 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-15, 17-22, 30, and 31 are rejected under 35 U.S.C. 101 because the bodies of the rejected claims do not recite technology, i.e. computer implementation or any other technology in a non-trivial manner. *In re Toma*, 197 USPQ 852 (CCPA 1978). *Ex parte Bowman* 61 USPQ2D 1669.

For a claim to be statutory under 35 USC 101 the following two conditions must be met:

1) The claimed invention must produce a "useful, concrete, tangible result" (*In re Alappat*, 31USPQ2d 1545, 1558 (Fed. Cir. 1994) and *State Street vs. Financial Signature Group Inc.*, 47 USPQ2d 1596' 1601-02 (Fed Cir. 1998));

AND

2) The claimed invention must utilize technology in a non-trivial manner (*Ex parte Bowman*, 61 USPQ2d 1665, 1671 (Bd. Pat. Pat. App. & Inter. 2001)).

As to the technology requirement, note MPEP Section IV 2(b). Also note *In re Waldbaum*, 173USPQ 430 (CCPA 1972) which teaches “useful arts” is synonymous with “technological arts”. In *Musgrave*, 167USPQ 280 (CCPA 1970), *In re Johnston*, 183USPQ 172 (CCPA 1974), and *In re Toma*, 197USPQ 852 (CCPA 1978), all teach a technological requirement.

In *State Street*, “in the technological arts” was never an issue. The invention in the body of the claim must recite technology. If the invention in the body of the claim is not tied to technological art, environment, or machine, the claim is not statutory. *Ex parte Bowman* 61USPQ2d 1665,1671 (BD. Pat. App. & Inter.2001)(Unpublished).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Todorov (U.S. PAT. 6564247 B1), Petreley et al. “Benchmark test serves up

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Secondhand Tomatoes and Argyle Toast," InfoWorld, July 5, 1993(hereinafter "Petreley et al.")and Klug et al.(U.S. PAT. 5790785A).

Re claims 1-6, 11, 17, 19, 20 and 21: Todorov discloses a method of producing a unique modified account name and second account name and unique account name based on a requested account name and the unique account name that has been determined to already exist(col. 2, lines 35-65,col. 4, lines 29-60, col. 6, line 45-col. 9, line 15, i.e. the computer program code indicates a looping function that effectively creates one ID and then another ID (the second ID)) , the method comprising the steps of:

comparing the modified account name, second account name, and first account name with a list of existing account names to determine whether the modified account name is unique(col. 5, lines 1-40,col. 6, lines 1-20, claim 5, i.e. "unique identifier"); and

if the first, second modified account name and first account name is unique, combining the requested account name with a numerical item to produce a first account name(col. 5, lines 1-40,col. 6, lines 1-20, i.e. the various parameters named in these two cols. are effectively used to produce account names or passwords).

As applied to claims 1-6,11, 17,19 and 21: Todorov disclose(s) the claimed invention except selecting a word element from a list of word elements and combining the word element and the requested account name to produce a modified account name;the word element is randomly selected from the list of word elements; wherein the word element is an adjective, an affix or a noun. However, in col. 1, paragraph 3 and 4

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thereof, Petreley et al. disclose(s) a data generator that randomly selects unique combinations of words to create realistic part names that are usable as account names. It would be obvious to one of ordinary skill in the art to modify the invention of Todorov based on the teachings of Petreley et al. The motivation to combine these references is Petreley et al. affirms the existence of a data generator that automatically generates names based on combining words to create new words that are functional as account names. That the word elements are different parts of speech (adjective, affix, noun) does not create a patentable distinctive feature since the computer can not identify parts of speech unless they are read in context. An adjective does function as a noun or verb depending on the content in which the word appears.

As applied to claims 1-6, 11, 17 and 21: Todorov disclose(s) the claimed invention except seeded name and providing the account name or random account name to the user for acceptance. However, in col. 18, lines 30-55, Fig. 12A, item 1216, Fig. 13A, item 1336, Fig. 13B, items 1340, 1348 thereof, Klug et al. disclose(s) user supplied information as the basis or "seed" for generating an acceptable user ID and presenting the user with the newly generated ID and providing the user with the option to accept or reject the generated information. It would be obvious to one of ordinary skill in the art to modify the invention of Todorov based on the teachings of Klug et al. The motivation to combine these references is the seeded name which is well-known in the art ensures a starting point for generating random names or numbers and presenting the generated ID to the user ensures the user has an opportunity to select a relevant ID meeting the user's preferences.

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Re claims 7,8 and 9: Todorov disclose(s) the claimed invention except the seed is a single digit number, a multi-digit number that is randomly generated, and a second multi-digit numerical seed. However, in col. 18, lines 30-55, Klug et al. does show seeded user ID. It would be obvious to one of ordinary skill in the art to modify the invention of Todorov based on the teachings of Klug et al. The motivation to combine these references to employ a numerical seed to generate a random account name to get the benefit of a known concept of seeded random numbers or names used to generate unique output.

Re claims 10,15 and 22: Todorov disclose(s) the claimed invention except the steps of combining the requested account name with an underscore. However, in col. 5, lines 1-40, Todorov indicates different formats and variables for the customized user ID. It would be obvious to one of ordinary skill in the art to employ underscores to further customize the user ID.

Re claims 12, 13 and 14: Todorov disclose(s) if the modified account name is not unique, the steps for producing the unique modified account name, second modified account name and first account name are repeated for up to a predetermined number of iterations until a unique modified account name, second modified account name, and first account name is produced(col. 6, line 45-col. 9, line 15, i.e. illustrates a looping function that repeats if the initial function fails to create the appropriate outcome).

Re claim 16: Todorov discloses computer-readable medium having computer-executable instructions(col. 9, lines 45-67) for a method of producing a unique modified account name based on a requested account name that has been determined to already exist(col. 2, lines 35-65,col. 4, lines 29-60, col. 6, line 45-col. 9, line 15, i.e. the computer program code indicates a looping function that effectively creates one ID and then another ID (the second ID)), the method comprising the steps of:

comparing the modified account name with a list of existing account names to determine whether the modified account name is unique(col. 5, lines 1-40,col. 6, lines 1-20, claim 5, i.e. "unique identifier").

As applied to claim 16: Todorov disclose(s) the claimed invention except selecting a word element from a list of word elements, and combining the word element and the requested account name to produce a modified account name. However, in col. 1, paragraph 3 and 4 thereof, Petreley et al. disclose(s) a data generator that randomly selects unique combinations of words to create realistic part names that are usable as account names. It would be obvious to one of ordinary skill in the art to modify the invention of Todorov based on the teachings of Petreley et al. The motivation to combine these references is Petreley et al. affirms the existence of a data generator that automatically generates names based on combining words to create new words that are functional as account names.

As applied to claim 16: Todorov disclose(s) the claimed invention except providing the modified account name to the user for acceptance. However, in col. 18, lines 30-55, Fig.

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12A, item 1216, Fig. 13A, item 1336, Fig. 13B, items 1340, 1348 thereof, Klug et al. disclose(s) presenting the user with the newly generated ID and providing the user with the option to accept or reject the generated information. It would be obvious to one of ordinary skill in the art to modify the invention of Todorov based on the teachings of Klug et al. The motivation to combine these references is presenting the generated ID to the user ensures the user has an opportunity to select a relevant ID meeting the user's preferences.

Re claim 18: Todorov disclose(s) the database(col. 4, lines 29-40).

As applied to claim 18: Todorov disclose(s) the claimed invention except the first and second word elements are randomly selected. However, in col. 1, paragraph 3 and 4 thereof, Petreley et al. disclose(s) a data generator that randomly selects unique combinations of words to create realistic part names that are usable as account names. It would be obvious to one of ordinary skill in the art to modify the invention of Todorov based on the teachings of Petreley et al. The motivation to combine these references is Petreley et al. affirms the existence of a data generator that automatically generates names based on combining words to create new words that are functional as account names.

Re claim 23: Todorov disclose(s) a computer-readable medium having computer-executable instructions(col. 9, lines 45-67) for performing a method of producing a unique random account name in response to a request by a user(col. 4, lines 29-60, col. 5, lines 1-40, col. 6, lines 1-col. 9, line 15):

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from the database(col. 5, lines 45-60, col. 6, lines 1-25, claim 1);

comparing the account name with a list of existing account names to determine if the account name is unique(col. 5, lines 1-40,col. 6, lines 1-20, claim 5, i.e. "unique identifier"); and

As applied to claim 23: Todorov disclose(s) the claimed invention selecting a first word element including a list of word elements and selecting a second word element and combining the first and second word elements. However, in col. 1, paragraph 3 and 4 thereof, Petreley et al. disclose(s) a data generator that randomly selects unique combinations of words to create realistic part names that are usable as account names. It would be obvious to one of ordinary skill in the art to modify the invention of Todorov based on the teachings of Petreley et al. The motivation to combine these references is Petreley et al. affirms the existence of a data generator that automatically generates names based on combining words to create new words that are functional as account names. That the words are selected from a database vs. a list is not a patentable distinctive feature.

As applied to claim 23: Todorov disclose(s) the claimed invention except providing the modified account name to the user for acceptance. However, in col. 18, lines 30-55, Fig. 12A, item 1216, Fig. 13A, item 1336, Fig. 13B, items 1340, 1348 thereof, Klug et al. disclose(s) presenting the user with the newly generated ID and providing the user with the option to accept or reject the generated information. It would be obvious to one of ordinary skill in the art to modify the invention of Todorov based on the teachings of Klug

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et al. The motivation to combine these references is presenting the generated ID to the user ensures the user has an opportunity to select a relevant ID meeting the user's preferences.

Re claims 24, 25, 26 and 27: Todorov disclose(s) a computer-readable medium having computer-executable components(col. 9, lines 45-67) for producing a unique modified account name based on a requested account name that has been determined to already exist(col. 6, lines 1-15), comprising:

a user interface component for receiving an account name request(col. 9, lines 45-67, i.e. any general computer has a user interface component):

a database(col. 5, lines 45-60, col. 6, lines 1-25) component including a list of word elements and a list of existing account names(col. 2, lines 55-67, i.e. based upon information in the request and a selected profile document, a user ID file is created, and in col. 5, lines 1-50, the password is created from various words to fit various criteria, and claim 6);

a name generating component for (claim 1, col. 1, line 55-col. 2, line 10);

and a search component for comparing the modified account names with a list of existing account names to determine whether the modified account names are unique(col. 5, lines 1-40, col. 6, lines 1-20, claim 5, i.e. "unique identifier").

As applied to claims 24, 25, 26 and 27: Todorov disclose(s) the claimed invention except selecting word elements from the list of word elements and combining the word

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elements with the requested account name to produce modified account names, and the word elements are affixes or adjectives. However, in col. 1, paragraph 3 and 4 thereof, Petreley et al. disclose(s) a data generator that randomly selects unique combinations of words to create realistic part names that are usable as account names. It would be obvious to one of ordinary skill in the art to modify the invention of Todorov based on the teachings of Petreley et al. The motivation to combine these references is Petreley et al. affirms the existence of a data generator that automatically generates names based on combining words to create new words that are functional as account names. That the words are selected from a database vs. a list is not a patentable distinctive feature. That the word elements are different parts of speech (adjective, affix, noun) does not create a patentable distinctive feature since the computer can not identify parts of speech unless they are read in context. An adjective does function as a noun or verb depending on the content in which the word appears.

As applied to claim 24: Todorov disclose(s) the claimed invention except providing the modified account name to the user for acceptance. However, in col. 18, lines 30-55, Fig. 12A, item 1216, Fig. 13A, item 1336, Fig. 13B, items 1340, 1348 thereof, Klug et al. disclose(s) presenting the user with the newly generated ID and providing the user with the option to accept or reject the generated information. It would be obvious to one of ordinary skill in the art to modify the invention of Todorov based on the teachings of Klug et al. The motivation to combine these references is presenting the generated ID to the user ensures the user has an opportunity to select a relevant ID meeting the user's preferences.

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Re claim 28: Todorov disclose(s) the claimed invention except seeded name and providing the account name or random account name to the user for acceptance.

However, in col. 18, lines 30-55, Fig. 12A, item 1216, Fig. 13A, item 1336, Fig. 13B, items 1340, 1348 thereof, Klug et al. disclose(s) user supplied information as the basis or "seed" for generating an acceptable user ID and presenting the user with the newly generated ID and providing the user with the option to accept or reject the generated information. It would be obvious to one of ordinary skill in the art to modify the invention of Todorov based on the teachings of Klug et al. The motivation to combine these references is the seeded name which is well-known in the art ensures a starting point for generating random names or numbers and presenting the generated ID to the user ensures the user has an opportunity to select a relevant ID meeting the user's preferences.

Re claim 29: Todorov disclose a computer-readable medium(col. 9, lines 45-67) wherein the name generating component further produces a random account name(col. 5, lines 1-30)

the search component comparing the random account name with the list of existing account names to determine whether the random account name is unique(col. 5, lines 1-40,col. 6, lines 1-20, claim 5, i.e. "unique identifier").

As applied to claim 29:Todorov disclose(s) the claimed invention except selecting word elements from the list of word elements and combining the word elements with the requested account name to produce modified account names, and the word elements

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are affixes or adjectives. However, in col. 1, paragraph 3 and 4 thereof, Petreley et al. disclose(s) a data generator that randomly selects unique combinations of words to create realistic part names that are usable as account names. It would be obvious to one of ordinary skill in the art to modify the invention of Todorov based on the teachings of Petreley et al. The motivation to combine these references is Petreley et al. affirms the existence of a data generator that automatically generates names based on combining words to create new words that are functional as account names.

As applied to claim 29: Todorov disclose(s) the claimed invention except providing the modified account name to the user for acceptance. However, in col. 18, lines 30-55, Fig. 12A, item 1216, Fig. 13A, item 1336, Fig. 13B, items 1340, 1348 thereof, Klug et al. disclose(s) presenting the user with the newly generated ID and providing the user with the option to accept or reject the generated information. It would be obvious to one of ordinary skill in the art to modify the invention of Todorov based on the teachings of Klug et al. The motivation to combine these references is presenting the generated ID to the user ensures the user has an opportunity to select a relevant ID meeting the user's preferences.

Re claim 30: Todorov disclose a method of producing a unique account name based on a requested account name(claim 1) comprising:

receiving a request from a user for an account name(Abstract, col. 4, lines 10-40, claim 1);

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within the iteration limit; and wherein there is a limit to the number of iterations for which each one of the multiple solution sets is utilized, and when said limit is reached a different solution set is utilized, and wherein said list of account names must contain a fixed number of unique account names(col. 6, line 45-col. 9, line 15, i.e. shows iterations of looping functions until the desired result is achieved);

As applied to claim 30: Todorov disclose(s) the claimed invention except utilizing multiple solution sets to produce a listing of unique account names, said multiple solution set comprising: a first solution set to provide at least one unique account name based on the requested account name; a second solution set to provide at least one unique account name based on the requested account name, if one or more previously utilized solution sets did not provide said fixed number of unique account names; a third solution set to provide at least one unique account name based on the requested account name, by pre-pending the requested account name with an adjective from a list of words, if one or more previously utilized solution sets did not provide said fixed number of unique account names; and a fourth solution set to provide at least one unique account name, by combining two word elements from two lists of words, if one or more previously utilized solution sets did not provide said fixed number of unique account names.

However, in col. 1, paragraph 3 and 4 thereof, Petreley et al. disclose(s) a data generator that randomly selects unique combinations of words to create realistic part names that are usable as account names. It would be obvious to one of ordinary skill in

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the art to modify the invention of Todorov based on the teachings of Petreley et al. The motivation to combine these references is Petreley et al. affirms the existence of a data generator that automatically generates names based on combining words to create new words that are functional as account names.

As applied to claim 30: Todorov disclose(s) the claimed invention except presenting the user with said listing of unique names and allowing the user to select one of said listings as an account name, combining the requested account name with a numerical seed and multi-digit seed. However, in col. 18, lines 30-55, Fig. 12A, item 1216, Fig. 13A, item 1336, Fig. 13B, items 1340, 1348 thereof, Klug et al. disclose(s) user supplied information as the basis or "seed" for generating an acceptable user ID and presenting the user with the newly generated ID and providing the user with the option to accept or reject the generated information. It would be obvious to one of ordinary skill in the art to modify the invention of Todorov based on the teachings of Klug et al. The motivation to combine these references is presenting the generated ID to the user ensures the user has an opportunity to select a relevant ID meeting the user's preferences.

Re claim 31. Todorov disclose a method of producing a unique random account name in response to a request by a user(claim 1), the method comprising the steps of; request an automated generation of a new list of multiple alternate unique account names(col. 3, lines 1-15, claim 1).

As applied to claim 31: Todorov disclose(s) the claimed invention except providing without any input or suggestion of names from the user, a list of multiple alternate

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unique account names. However, in col. 1, paragraph 3 and 4 thereof, Petreley et al. disclose(s) a data generator that randomly selects unique combinations of words to create realistic part names that are usable as account names. It would be obvious to one of ordinary skill in the art to modify the invention of Todorov based on the teachings of Petreley et al. The motivation to combine these references is Petreley et al. affirms the existence of a data generator that automatically generates names based on combining words to create new words that are functional as account names.

As applied to claim 31: Todorov disclose(s) the claimed invention except providing the user with the ability to enter a new string for use as an account name. However, in col. 18, lines 30-55, Fig. 2A and 2B, Fig. 12A, item 1216, Fig. 13A, item 1336, Fig. 13B, items 1340, 1348 thereof, Klug et al. disclose(s) the user submitting a unique ID and password, and the user-supplied information functioning as a base for ID creation. It would be obvious to one of ordinary skill in the art to modify the invention of Todorov based on the teachings of Klug et al. The motivation to combine these references is presenting the generated ID to the user ensures the user has an opportunity to select a relevant ID meeting the user's preferences.

5. As applied to claims 1-31: Nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious. Cf. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability). Common situations involving nonfunctional descriptive material are:

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- a computer-readable storage medium that differs from the prior art solely with respect to nonfunctional descriptive material, such as music or a literary work, encoded on the medium;
- a computer that differs from the prior art solely with respect to nonfunctional descriptive material that cannot alter how the machine functions (i.e., the descriptive material does not reconfigure the computer), or
- a process that differs from the prior art only with respect to nonfunctional descriptive material that cannot alter how the process steps are to be performed to achieve the utility of the invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Debra F. Charles whose telephone number is (703) 305-4718. The examiner can normally be reached on 9-5 Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung Sough can be reached on (703) 308-0505. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-5771.

Debra F. Charles

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Examiner

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dfc


HYUNG SOUH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600